

REMARKS/ARGUMENTS

Claims 34, 36 to 39, 41 to 49 and 51 to 58 are pending in this application. Claims 34, 39, 41, 42, 44 to 48 and 53 to 56 have been amended, claims 57 and 58 have been added and claims 35, 40 and 50 have been canceled each for the purpose of advancing the case toward allowance. Differences between the presently pending claims and the previously filed claims should not be viewed as acquiescence to any of the Examiner's rejections. The new claims and amended claims are believed to include no new matter.

The Examiner rejects claims 34 to 56 under 35 USC 112, first paragraph, stating that the claims contain subject matter not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention at the time of filing. The Examiner indicates that the claims are not the specifically contemplated invention supported by the specification. Applicant traverses the rejection.

Applicant believes the Examiner is indicating that if newly filed claims in an application do not reflect the subject matter of the originally filed claims, then the new claims contain new matter. This in fact is not the case. 37 CFR 1.121(f) states that: "No amendment may introduce new matter into the disclosure of an application." However, it is well known that a patent application may disclose more than one invention and that applicants may draw upon disclosure originally filed in the application when drafting new claims in the application or in a related application.

Applicant submits that the invention as presently claimed is fully disclosed in the specification. Applicant submits that support for each of the pending claims is found in the specification as originally filed. For example, independent claim 34 is supported, for example, in originally filed claim 1, steps ii and iii (the meaning of "ablate", as defined by Webster's dictionary, as "to remove"). Independent claim 48 and claim 39 are supported, for example, by originally filed claim 14, steps ii and iii. Claim 42 is supported, for example, at page 21, line 10 to 12. Claims 36, 37 and 49 are supported, for example, in originally filed claims 4 and 5. Claims 38, 41 and 51 are supported for example, in originally filed claim 3. Claims 43 to 47 and 52 to 56 are supported, for example, at page 3, lines 11 to 12, page 19, line 5, page 14, lines 19 to 20 and page 14, lines 2 to 13. New claims 57 and 58 are supported, for example, in originally filed claim 2.

Further, beginning at line 6 of page 3 of the Office action, the Examiner states on the record that "the specification provides literal support for the newly added claims". Therefore, applicant respectfully submits that the present rejection is improper and should be withdrawn.

The Examiner also rejects the claims under the 35 USC 112, second paragraph enablement provision, stating that a disclosure cannot teach one to make something that has not been described. Applicant traverses the rejection.

Applicant has shown that the specification properly discloses the invention. Therefore applicant requests that this rejection be withdrawn.

The Examiner rejects certain of the pending claims under 35 USC 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant traverses the rejection. However, revisions have been made to the claims which applicant believes obviate the Examiner's rejection.

The Examiner rejects claims 37 to 41 and 48 to 51 under 35 USC 102(b) as being anticipated by König et al (Nature (1995) 377:20-21). Applicant traverses the rejection.

The Examiner indicates that König et al anticipates the presently claimed invention because the reference teaches visualization of human spermatozoa and CHO cells utilizing a two-photon microscope at 700 to 1000 nm and that the cells incurred cell damage leaving the cells unable to divide.

Applicant submits that the claimed invention relates to the specific targeting of the nucleus for ablation, for example, as described in the first paragraph at page 33 of the specification, thereby distinguishing the present invention from König et al. That is, targeting the nucleus for ablation is different from damaging the cell so that cell is unable to divide as may be described in König et al. König et al states that "UV laser radiation may induce genetic as well as non- genetic damage to the gametes." (emphasis added). See, König et al, page 2163, last full paragraph. The present invention is not directed to the general "damaging" of the cell but specifically to the ablation, or removal, of the nucleus. Therefore, applicant submits that the invention is not anticipated by König et al and requests that the rejection be withdrawn.

The Examiner rejects claims 42 to 47 and 52 to 56 under 35 USC 103(a) as being unpatentable over Campbell et al (WO97/07668 when taken with König et al (Nature (1995) 377:20-21 and further in view of Squirrell et al (Nat Biotech (1999) 17:763-767). Applicant submits that each of these references alone or in combination does not disclose teach or even suggest the present invention.

To establish a prima facie case of obviousness, three criteria must be met. First there must be some suggestion or motivation to combine the teaching of the references. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest each of the claim limitations. Applicant submits that these requirements have not been met.

For example, there is no motivation to combine the references. Campbell et al teach reconstruction of mammalian embryos. König et al discuss the effect of photostress during micromanipulation of gametes. Squirrell et al discuss the dynamics of mitochondrial distribution in hamster embryos and other aspects of three-dimensional cytoarchitecture in highly photosensitive specimens such as mammalian embryos. There is no suggestion or motivation found either in the references or in the knowledge generally available to one of ordinary skill in the art to combine the teachings of the references. As stated in MPEP 2142:

"The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure." (emphasis added). The Examiner points to nothing in the art that would motivate an artisan of ordinary skill to combine the cited references. Even if motivation to combine the references and a reasonable expectation of success existed, all of the limitations present in certain of the pending claims are not present in the cited references. For example, certain pending claims specify ablating the nucleus using laser light or by using light energy provided by the microscope. Therefore, applicant submits that the rejection should be withdrawn.

In conclusion, applicant has shown that the present claims satisfy the requirements of 35 USC 112, first and second paragraphs and are not anticipated or made obvious by any of the cited references under 35 USC 102 or 103. Therefore, applicant submits that the presently pending claims are allowable and respectfully requests that the Examiner pass the above-identified application to allowance.

If any issues remain to be addressed in this matter, which might be resolved by discussion, the Examiner is respectfully requested to call applicants' undersigned counsel at the number indicated below.

Respectfully submitted,



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